

REMARKS

Claims 11 to 22 are now pending. A new Abstract has been submitted. No new matter has been added.

Applicants respectfully request reconsideration of the present application in view of this response.

Information Disclosure Statement

The Examiner requests submission of an IDS including all documents cited in Applicants' Specification of Record. Applicants will prepare and submit an IDS including any uncited publications identified in the Specification. For clarity purposes, the Supplemental IDS will not be included in this submission.

Specification

The Abstract was objected to because the abstract was considered "too long." According to MPEP § 608.01(b), an abstract should be 150 words or less. Applicants' Abstract of Record is less than 100 words in length. Accordingly, Applicants respectfully submit that the Abstract is not "too long." In the event that the Examiner did not see Applicants' Abstract submitted in Applicants' Preliminary Amendment dated October 12, 2000, Applicants have formally re-submitted above Applicants' Abstract from Applicants' Preliminary Amendment. No new matter has been added. Applicants respectfully request withdrawal of the objection to the Abstract (Specification).

35 U.S.C. § 112, first paragraph

Claim 11 was rejected under 35 U.S.C. § 112, first paragraph, as unenabled. Specifically, claim 11 was rejected because the Specification allegedly does not describe what the conversion process does to the user information in the digital network and what happens to the data as it is converted; how the voice connection path is sent over the network; and how the bandwidth is reduced.

Applicants respectfully submit that the Specification does properly enable claim 11 and all other claims in the present application. In particular, the Specification describes that the conversion process may be carried out in a data network, where the data may be broken into segments and then transmitted. See Specification, page 12, lines 5-14; and page 12, lines 24-25. See also page 5, lines 7-23; page 5, line 30 - page 6, line 6; and page 6, lines 11-23. Further the Specification describes sending the voice connection path over the data network.

See *id.*; page 8, lines 1-15; and FIG. 3. The Specification also describes how the bandwidth is reduced, how the path is manipulated and provides a step-by-step example of the same. See Figure 3 and accompanying text; page 7, lines 9-22; and page 14, lines 4-5.

Claim 19 was rejected under 35 U.S.C. § 112, first paragraph as unenabled. Specifically, claim 19 was rejected because the Specification allegedly does not describe the sending and receiving terminals connected directly or via a digital transmission link to avoid extraneous coding. Applicants respectfully submit that claim 19 is enabled by the Specification, and described in at least FIG. 3 and accompanying text on page 11, line 5 et seq.; page 8, lines 4-15; page 7, lines 3-7; and page 6, lines 4-7, 16-19, 21-25.

Accordingly, in light of the foregoing, Applicants respectfully submit that claims 11 and 19, as well as the remaining claims 12-18 and 20-23 are allowable; withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, of those claims is respectfully requested.

35 U.S.C. § 102(e) – Adler reference

Claims 11 to 22 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication No.2001/0035977 to Adler et al. (“Adler reference”).

The Adler reference purportedly concerns a facsimile network having a plurality of nodes (10)-(14) which are disposed at different locations in the world so that an originating fax machine is associated with one of the nodes for transmitting a fax over a local public telephone line (PSTN). Title and Abstract, lines 1-4. The Adler reference refers to a node receiving a fax transmission in a normal transmission mode, then converting it to a digitized compressed and encrypted image which is transmitted over a primary network to a destination node by a predetermined route. Abstract, lines 4-10. The Adler reference further refers to the node decompressing and de-encrypting the image and converting it to a facsimile image for transmission to a destination fax in normal mode over PSTN. Abstract, lines 10-12. The Adler reference allows for a node operating as a central node to receive transmission for routing directly to the fax or for directing via another network link to the node. Abstract, lines 13-15.

In contrast, claim 11 recites a method for reducing bandwidth when transmitting data between a sending terminal and a receiving terminal over a voice connection path using a digital data network. Claim 11 requires "converting, within the digital data network, a coding of user information of the transmitted data between a data transmission in the voice connection path and a data transmission in the digital data network so as to transmit the user information via the coded voice connection path on at least one first section of the digital data

network and transmit the user information by a method suitable for the digital data network on at least one second section of the digital data network." The Adler reference does not identically describe all of these steps, and certainly not "transmit[ting] the user information via the coded voice connection path on at least one first section of the digital data network and transmit[ting] the user information by a method suitable for the digital data network on at least one second section of the digital data network." Instead, the Adler reference appears to involve taking an entire message, converting it, encrypting it, and sending the entirety along a path. See Adler reference, Abstract and paragraphs [0027] - [0035].

To reject a claim under 35 U.S.C. § 102, the Patent Office must demonstrate that each and every claim limitation is identically disclosed in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

Accordingly, the Adler reference does not identically describe all of the features of claim 11. Claims 12 to 22 depend from claim 11 and are allowable over the Adler reference for at least the same reasons as claim 11. Withdrawal of the rejection of claims 11 to 22 is respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that all of claims 11 to 22 of the present application are allowable at least for the foregoing reasons.

CONCLUSION

In view of all of the above, it is believed that the objection to the Abstract, and the rejections of claims 11 to 22, under 35 U.S.C. §§ 112 and 102(e), have been obviated, and that all claims 11 to 22 are allowable. It is therefore respectfully requested that the objection and rejections be reconsidered and withdrawn, and that the present application issue as early as possible.

The Examiner is respectfully encouraged to contact the undersigned via telephone if such communication might advance allowance of the present application.

Respectfully submitted,

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